Appl. No. 10/608,885
Response Dated November 30, 2006

MPJ-D1

REMARKS/ARGUMENTS

This communication is submitted in response to the Non-Final Office Action of June 30, 2006. In the Action, claims 1 and 3-71 were rejected under 35 U.S.C. 102(e) as being anticipated by Laverty et al. (US Patent 6,362,895). No claims are amended, cancelled or added in this Response.

35 U.S.C. 102(e) Rejections

In earlier communications, the Laverty reference has been analyzed and contrasted with the pending claims in some detail. That earlier analysis remains applicable, but will not be fully repeated again herein to avoid unnecessary repetition. In brief, Laverty and the pending application both disclose systems and methods for allowing a user to access a remote Web server and provide user information that is combined with pre-designed template features to create a personalized custom electronic product design, such as a business card, for subsequent printing. Laverty teaches a method wherein the user's participation is strictly limited to providing only the raw data to be incorporated by the server into a product design. The Laverty user is not provided access to a downloadable and editable template. By contrast, Applicants' claims relate to a method employing downloadable editing tools and downloadable editable templates allowing the user to download and directly edit a desired template to create a product design at the user computer that is uploaded to the server.

The relevant aspects of the Laverty system are summarized in Laverty at col. 9, line 47 to col. 10, line 18. If a Laverty user desires to create a custom printed

Appl. No. 10/608,885
Response Dated November 30, 2006

MPJ-D1

document containing user information, the information to be incorporated into the document is provided by the user in response to specific prompts in an order form. The data entered by the user is sent from the user computer to the Laverty web site (col. 9, lines 49-51 and 62-65) where the user-supplied data is combined at the server with predefined product design information stored at the server to create a product design. The server creates a PDF from the design and sends the PDF back to the user for review (col. 10, lines 1-8). If the user is not satisfied with the product design shown in the PDF received from the server, the user must again view and edit the order form and resubmit the data to the server. At the server, newly submitted information is used to create a revised product and a PDF of the revised product will be returned to the user for review (col. 10, lines 14-17).

In applying Laverty to pending claim 1, the Examiner points out that Figs. 3 and 4 of Laverty show that a communication link exists between a user and the Laverty server. The depicted theoretical capability to transfer information to or from a user does not inherently teach any specific method or transfer over that link, such as the downloading of specific tools or templates for performing specific operations. Similarly, the depiction of software modules, product templates and other information stored at the Laverty server does not inherently teach that those things are intended to be downloaded to and used by the user at the user computer. When the Laverty figures are examined in light of the Laverty specification, no such teaching is found.

The Examiner cites four sections of text from the Laverty specification as teaching the use of downloadable tools at the user computer to allow the user to edit a downloadable template. Applicants submit that none of the four sections make any relevant teaching. The first two sections are in the "Background of the Invention " section of the Laverty reference. Col. 3, lines 1-11 relate to a prior art process shown in Fig. 2. This section describes prior art processes performed by a print vendor

Appl. No. 10/608,885
Response Dated November 30, 2006

MPJ-D1

within the print vendor's business. Laverty makes it clear at col. 2, lines 19-21, that the interaction with the customer is not automated.

Another cited prior art section at col. 6, lines 20-39 relates to the use of standalone commercial software applications, such as Adobe Photoshop and Freehand, of the type that are installed on the user computer and used locally. These software products are not Web-based downloadable applications. The third section cited by the Examiner at col. 10, line 13-27 is seen as supporting the Applicants' position on the teaching of Laverty. This section makes it clear that the user is not allowed to download and edit a product template at the user computer, but must instead submit the user's data on an "order form" that is then sent to the server where the document template is maintained and edited. Finally, col. 13, lines 1-15 list various information and files that are stored at the server, but makes no teaching that these files are intended for or capable of being downloaded to the user computer for use by the user.

Looking at the specific elements of pending claim 1, the first step recited is "downloading one or more product design software tools to a user computer, the tools being adapted to execute in the browser of the user computer and allow the user of the user computer to edit a downloaded product design template at the user computer to create a custom product design". The Laverty specification, and the Laverty figures interpreted in light of the Laverty specification, makes no teaching that discloses downloading tools allowing a user to edit a downloaded product design template.

The second step recited in pending claim 1 is "providing a plurality of template images for viewing by the user of the user computer, the images representing electronic product design templates editable at the user computer by the user". There is no teaching of this in Laverty. In fact, Laverty does not show a template in any figure and makes no mention of at all of displaying template images for viewing by

Appl. No. 10/608,885
Response Dated November 30, 2006

MPJ-D1

the user. Looking at col. 9, lines 61-65, Laverty simply states that the customer "goes to the web site and selects a particular product to order". The mere displaying of a text list of product descriptions would fully meet the Laverty description.

The third step of claim one is "in response to the user's selection of one of the template images, downloading an editable product design template associated with the selected template image, the downloaded product design template being a partially completed electronic product design". As mentioned above, Laverty teaches away from any notion that the user might be allowed to have access at the user computer to an editable template.

The final step recited in claim 1 is "allowing the user to use one or more of the tools to edit the downloaded template to incorporate content at the user computer into the downloaded product design template to create a custom electronic product design at the user computer". Again, no teaching of this is found in Laverty.

The above comments regarding claim 1 are likewise applicable to independent claim 9 and 13 and to dependent claims 3-8, 10-12, and 14-71. In light of the above comments, it is believed that all pending claims are now allowable and favorable action on all claims is respectfully requested.
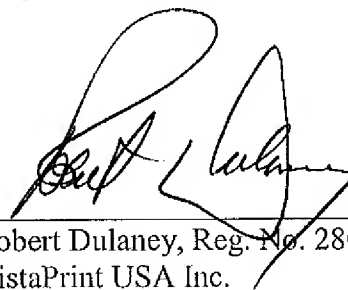
Request for Clarification of Examiner Remarks

In the Action of June 30, 2006, the Examiner's detailed application of Laverty to claim 1 was contained in a single lengthy sentence beginning near the bottom of page 2 and continuing to the fifth line of page 4 of the Action. A precise understanding of the Examiner's reasoning was hampered by instances of incomplete parenthetical phrases. For the Examiner's convenience, copies of pages 2-4 are supplied herewith. Two lines on page 2 and four lines on page 3, indicated by

Appl. No. 10/608,885
Response Dated November 30, 2006

MPJ-D1

asterisks in the left hand margin of these pages, contain an open parenthesis beginning a parenthetical phrase for which the associated close parenthesis is either unclear or missing. If, after considering the arguments presented above, the Examiner decides to maintain and repeat this rejection in the Examiner's response to this Amendment, the Examiner is respectfully requested to review and amend the Examiner's comments to insert the missing close parentheses at the appropriate locations in this sentence so there will be no confusion regarding the Examiner's analysis.

If the Examiner believes a telephone call would serve advance the prosecution of this case, he is invited to call the undersigned at the number below.

Respectfully submitted,

Date: November 30, 2006

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DETAILED ACTION

Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the
> United States before the invention thereof by the applicant for patent, or on an international application by
> another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before
> the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application being

examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35

U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the

amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 1-71 are rejected under 35 U.S.C. 102(b) as being anticipated by <u>Laverty et al.</u>

(6,362,895).

With regard to claim 1, <u>Laverty et al.</u> teaches a computer implemented method for creating an

electronic product design (see fig. 3 and fig.4, which depicts how a user can create an electronic

product to produce a print design electronically submitted to a print vendor), the method

comprising: downloading (e.g. reads on fig. 3, which depicts how the forms or template to make

the print order is downloaded or received from a website) one or more product design software

tools (see abstract, the software being the modules, fig. 6, depicts a database that stores the

software modules (e.g. fig. 4, clearly shows the use of product module (409) and pricing module

(411), the modules being the different software tools to produce and submit the print orders, also

see fig. 5, item 460, which clearly depicts the product design software tools) to a user computer

(404), the tools being adapted to execute in the browser of the user computer (step 1212, e.g. fig

3 depicts how a user can use computer having a browser being used to access a website and the

software modules could be stored in a webserver or downloaded to the user (see fig. 4) or install

into the user's computer as suggested in fig. 19a) and allow the user of the user computer to edit

a downloaded product design template at the user computer to create a custom product design

(e.g. reads on col. 3, lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15),

� providing a plurality of template images for viewing by the user of the user computer (e.g. fig. 6

and 8-9, depicts how the user(s) can use the different template of products as shown in fig. 6, line

465, and fig. 8 depicts how different templates are created by a master service as farm services,

� and fig. 9, depicts the farm service as depicted as different print jobs as (622, 624 and 626, which

could be selected by the user from the catalogs products kits (465), the images representing

electronic product design templates editable at the computer by the user (e.g. reads on col. 3,

lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15), in response to the   ♭

user's selection of one of more template images, downloading an editable product design (e.g.

reads on fig. 3, which depicts how the forms or template to make the print order is downloaded

or received from a website) template associated with the selected template image (see abstract

and fig.9), the downloaded product design template being a partially completed product design

� (reads on figs. 5 and 6, which depicts how the customer is provider with product/design

information and fig. 13, depicts how the user is provided with the partially completed electronic

� product design (see steps 902, 906, 908 and 910, wherein the user is requested for information

to fill the product design form as described in steps 913, and 914), allowing the user to use one or more of the tools to edit the downloaded template to incorporate at the user computer into the downloaded product design template to create a custom electronic product design at the user computer (e.g. reads on col. 3, lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15).

With regard to claims 2-3, Laverty et al. further teaches wherein the tools are downloaded to the user computer network and allowing the user to upload the electronic product design over the network to a server (see abstract and fig. 4). invisible indicia are printed with a luminescent ink or toner (see page 7).

With regard to claim 4, Laverty et al. further teaches allowing the user to place an order for production of a quantity of a physical product corresponding to the electronic product design (e.g. col. 10, lines 13-27).

With regard to claim 5, Laverty et al. further teaches wherein the tools display the electronic product design to the user in WYSIWYG form (e.g. col. 8, lines 16-31).

With regard to claims 6-7, Laverty et al. further teaches allowing the user to modify at least one feature of the selected product design template or user content during the electronic product design process (e.g. col. 8, lines 9-15).

With regard to claim 8, Laverty et al. further teaches wherein the template images are displayed at a reduced size that allows a plurality images to be simultaneously displayed to the user (e.g. col. 4, lines 4-17).

With regard to claim 16, Laverty et al. further teaches wherein the user is creating an electronic product design for another party (e.g. reads on fig. 4, which depicts how another